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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/734,811
Filing Date: December 11, 2003
Appellant(s): BHAN ET AL.

Eric L. Prahl
Registration No.: 32,590
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/10/2011 appealing from the Office action mailed 2/19/2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-6, 8 and 10-14

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

Gal et al. (WO 01/52106 A2).

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 1 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**
3. **Independent Claims 1 and 6** disclose storing event information in a database and then matching the stored information with stored profile information to determine invitees to receive specific emails with a plurality of events.
4. However, the Examiner is unclear how the system/user would determine when the matching/distribution step (batch processing) would take place. Is there a threshold of events to be saved in the database before the match is sent to users? Is there a threshold of time (every minute, day, week, month) that takes place before the match is sent to users?
5. If there is no threshold for the batch processing (time or amount of messages), then it is unclear to the Examiner why the event information would even have to be saved, and would not directly be matched to a user once received.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-6, 8, and 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gal et al. (WO 01/52106 A2).

8. As per **independent Claim 1**, Gal discloses a computer-implemented method of selectively distributing invitations for a plurality of events (Abstract), the method comprising the steps of: electronically storing in an event information database event records (Figs. 1-2, Server 26; C3 L6-11, the user creates a message and provides profile information – the message and profile information would inherently be saved in order to do a query on members, the message could contain a plurality of message types – to include an event or plurality of events), wherein the event information stored in each of the plurality of events records includes one or more corresponding invitee selection criteria (C3 L6-15, profile information); electronically storing in a member information database (Figs. 2 and 4) member information for each of a plurality of members (C3 L8-15, database of recipients); for each event of the plurality of events, in a computer system comparing the stored event information obtained from the member information database (Figs. 1-4) and the stored member information to identify for each member among the plurality of members all events among the plurality of events that match the stored member information for that member (C5 L5-14, relational database, system uses profile information attached to message/invitation information for matching recipients to the message/invitation); electronically storing match information about all of the identified matches, wherein for each of at least some of the members among the plurality of members the stored match information identifies multiple events among the plurality of events that were

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detected for that member (pgs.5-6, Fig.5, multiple invitations stored per user profile/key number); and based on the stored match information, generating and sending an electronic invitation message to the electronic mailbox (dynamically-created Web page) of each member of the plurality of members for which matches are identified in the stored match information (C2 L11-13, C3 L8-15, C4 L5-10, C5 L6-12, C6 L7-13), wherein each electronic invitation message invites its corresponding recipient to the events for which matches were detected for that corresponding recipient (Invitations, Fig.4, C5 L26-27).

9. Gal fails to expressly disclose storing event information in a (long term) database (although the use of a cache database would be inherent for matching purposes) and then matching the stored event information with stored profile information to determine invitees to receive specific emails with a plurality of events.
10. However, as indicated in the 112 rejection above, saving the event information in a long-term storage database would be unnecessary for matching the event information with system users, and the Examiner believes the invention disclosed by Gal to be an advancement on the instant invention.
11. Gal discloses instantaneously matching the event information as received by the system with specific invitees, based on saved profile information (Figs.1-5, C5 L21-27), and it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included saving the received event information for matching at a later time (Batch Processing – common industry term and processing element) – but the matching element in the method/system disclosed by Gal would

be a more efficient use of time and storage space. (See KSR [127 S Ct. at 1739]

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

12. Gal also fails to expressly disclose receiving an “e-mail” as described by the applicant, wherein each of the plurality of members has a corresponding electronic mailbox for receiving electronic communications for storage and later retrieval by that member.
13. However, Gal does disclose sending invitations which can be done by “e-mail” (pg.4 L8), and it would have been obvious to use a variety of available e-mail formats available at the time the invention was made to include an e-mail system that included an electronic mailbox for receiving electronic communications for storage and later retrieval by that member, for the purpose of providing customers with a wide variety of formats for receiving sent messages.
14. Furthermore, Gals fails to expressly disclose sending “all of” the matching events/invitations in one e-mail to the user.
15. However, Gal does disclose combining/storing event information by user/key number to be used on specific user dynamically created web pages (Fig.5, pg.5 L 15-25, combined event information disclosed as possible information available) (See also: BPAI Decision, 3/7/2007, pg.4 &5), and Gal also discloses electronically sending invitation information to users (pgs.4-5).
16. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included sending “all of” the matching

events/invitations in one e-mail to the use in the system disclosed by Gal, for the advantage of providing a method of invitation delivery with the ability to save system resources for both the user and the sender, by combining information sent. (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

17. As per **independent Claim 6**, Gal discloses a computer-implemented method of selectively distributing invitations for a plurality of events (Abstract), the method comprising: electronically storing in an event information database (Figs. 1-2, Server 26 – Server equivalent to Database – include cache memory) event information (C3 L6-11, the user creates a message and provides profile information – the message would inherently be saved in order to do a query on members; the message could contain a plurality of message types – to include an event or plurality of events – the type of message would be non-functional descriptive material), wherein the event information stored in each of the plurality of events records includes one or more corresponding invitee selection criteria (C3 L6-15, profile information); electronically storing in a member information database (Figs. 2 and 4) member information for each of a plurality of members (C3 L8-15, database of recipients), wherein the member information for each of the plurality of members includes one or more member preferences (C3 L8-15, C5 L6-12, C6 L7-13); for each event of the plurality of events, in a computer system comparing the stored event information obtained from the member information database (Figs.1-4) and the stored member

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information to determine for each member among the plurality of members all events among the plurality of events to which that member should be invited (system uses profile information attached to message/invitation information for matching recipients to the message/invitation, pg 3, - in the case all events would be the single message being matched) based on (a) matches between the member information and the at least one invitee selection criterion for each of the plurality of events and (b) matches between the event information and the at least one member preference for the respective members (C2 L11-13, C3 L8-15, C5 L6-12, C6 L7-13); electronically storing invitation information indicating which events among the plurality of events each of the plurality of members should receive an invitation to, wherein for each of at least some of the members among the plurality of members the stored invitation information identifies multiple events among the plurality of events that were detected for the member (pgs.5-6, Fig.5, multiple invitations stored per user profile/key number); and based in the stored invitation information, generating and sending an electronic invitation message to each member of the plurality of members identified in the stored invitation information for receiving an invitation, wherein each electronic invitation message invites its corresponding recipient to the events identified for that recipient in the invitation information (Fig.4, pg.5, using tables 98 and 100 - electronic message)

18. Gal fails to expressly disclose storing event information in a (long term) database (although the use of a cache database would be inherent for matching purposes)

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and then matching the stored event information with stored profile information to determine invitees to receive specific emails with a plurality of events.

19. However, as indicated in the 112 rejection above, saving the event information in a long-term storage database would be unnecessary for matching the event information with system users, and the Examiner believes the invention disclosed by Gal to be an advancement on the instant invention.

20. Gal discloses matching the event information as received by the system with specific invitees, based on saved profile information (Figs. 1-5, C5 L26-27), and it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included saving the received event information for matching at a later time (Batch Processing – common industry term and processing element) – but the method/system disclosed by Gal would be a more efficient use of time and storage space. (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

21. Gal also fails to expressly disclose sending/generating/receiving an “e-mail” as described by the applicant, wherein each of the plurality of members has a corresponding electronic mailbox for receiving electronic communications for storage and later retrieval by that member.

22. However, Gal does disclose sending invitations which can be done by “e-mail” (pg. 4 L8), and it would have been obvious to use a variety of available e-mail formats available at the time the invention was made to include an e-mail system that

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included an electronic mailbox for receiving electronic communications for storage and later retrieval by that member, for the purpose of providing customers with a wide variety of formats for receiving sent messages.

23. Furthermore, Gals fails to expressly disclose sending “all of” the matching events/invitations in one e-mail to the user.

24. However, Gal does disclose combining/storing event information by user/key number to be used on specific user dynamically created web pages (Fig.5, pg.5 L 15-25, combined event information disclosed as possible information available) (See also: BPAI Decision, 3/7/2007, pg.4 &5), and Gal also discloses electronically sending invitation information to users (pgs.4-5).

25. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included sending “all of” the matching events/invitations in one e-mail to the use in the system disclosed by Gal, for the advantage of providing a method of invitation delivery with the ability to save system resources for both the user and the sender, by combining information sent. (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

26. As per Claim 2 and 11, Gal discloses wherein the one or more corresponding invitee selection criteria comprise an area of practice (Fig.4, Occupation).

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27. As per Claim 3 and 12, Gal discloses wherein the one or more corresponding invitee selection criteria for each of the plurality of events are selected by a sponsor of the respective event (C3 L8-15, user creates message with profile).
28. As per Claim 4 and 13, Gal discloses wherein the one or more corresponding invitee selection criteria comprise an identifier that uniquely identifies an individual member (C5 L6-12, e-mail address).
29. As per Claim 5 and 14, Gal discloses wherein the one or more corresponding invitee selection criteria comprise a list of identifiers, each of which uniquely identifies an individual member (e-mail address, web page).
30. As per Claim 8, Gal discloses wherein, in the comparing step, a decision to invite a given member to a given event requires (a) a match between the member information for the given member and the at least one invitee selection criterion for the given event and (b) a match between the event information for the given event and the member preference for the given member (pgs.3-5).
31. As per Claim 10, Gal discloses wherein, in the comparing step, a decision to invite a given member to a given event requires (a) a match between the member information for the given member and the at least one invitee selection criterion for the given event and (b) a match between the event information for the given event and the member preference for the given member (pgs.3-5).

(10) Response to Argument

1. The Appellant has indicated that the invention, as claimed, sufficiently describes the process/method steps which applicant regards as the invention.
2. However, the Examiner disagrees and still believes that it is unclear how the system/user would determine when the matching/distribution step (batch processing) would take place. Without a specified threshold for the batch processing (time or amount of messages), then it is unclear to the Examiner why the event information would even have to be saved, and would not directly be matched to a user once received.
3. Furthermore, the Appellant has made the argument that the cited prior art of Gal fails to teach or disclose storing event information for a plurality of events in a (long term) database, and then matching the stored event information with stored profile information to determine invitees to receive specific emails with a plurality of events.
4. However, as indicated in the 112 rejection above, saving the event information in a long-term storage database would be unnecessary for matching the event information with system users (the use of a cache/short-term database would be inherent for matching purposes of Gal's invention), and the Examiner believes the invention disclosed by Gal to be an advancement on the instant invention.
5. Gal discloses instantaneously matching the event information as received by the system with specific invitees, based on saved profile information (Figs.1-5, C5 L21-27), and it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included saving the received event

information for matching at a later time (Batch Processing – common industry term and processing element) – but the matching element in the method/system disclosed by Gal would be a more efficient use of time and storage space. (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

6. Furthermore, although Gals fails to expressly disclose sending “all of” the matching events/invitations in one e-mail to the user.
7. Gal does disclose matching and storing combined event information by user/key number to be used on specific user dynamically created web pages (Fig.5, pg.5 L 15-25, combined event information disclosed as possible information available) (See also: BPAI Decision, 3/7/2007, pg.4 &5).
8. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included sending “all of” the matching events/invitations in one e-mail to the use in the system disclosed by Gal, for the advantage of providing a method of invitation delivery with the ability to save system resources for both the user and the sender, by combining information sent. (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Jonathan Ouellette/

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